

Appl. No. 09/879,794
Amdt. dated May 20, 2005
Amendment under 37 CFR 1.116 Expedited Procedure
Examining Group 1761

PATENT

REMARKS/ARGUMENTS

I. Status of the Claims

Claims 1-31 are pending. Claims 1-20 are allowed. Claims 21-31 are rejected.

II. The Present Amendment

No new matter is introduced by the present amendment.

The amendment to claim 21 would introduce the recitation "not containing a preservative" into the claim. The recitation is supported throughout the specification, which sets forth at, for example, page 10, lines 26-27, the surprising finding that contacting nuts with water alone is sufficient to delay the development of rancidity.

Applicants respectfully submit that the amendment to claim 21 is appropriate at this time as it puts the case in condition for allowance or, alternatively, puts the case in better condition for appeal. Applicants further respectfully submit that the amendment does not raise any issues requiring a further search, since the Examiner has manifestly already searched methods of delaying rancidity in nuts by contacting them with water.

III. The Office Action

The Final Action dated December 20, 2004 (the "Action"), indicates that claims 1-20 are allowed. The Action rejects claims 21-31 on two grounds over one reference, Gilgen, U.S. Patent No. 6,156,361 ("Gilgen"). Applicants amend in part and traverse.

1. Rejection of the claims as anticipated by Gilgen

The Action rejects claims 21, 23, 25 and 26 as anticipated under 35 U.S.C. § 102(e) over Gilgen. According to the Action, Gilgen discloses treating a nut with an anti-oxidant to increase the shelf life of the nut. The Action states that claim 21 appears to differ from Gilgen in the recitation of the moisture content of the nut, but that one of skill would have expected the final nut product to have the same moisture content of the original. Applicants amend in part and traverse.

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What Gilgen teaches is mixing an anti-oxidant substance with a heated liquid to form a treatment solution, and contacting nuts with the treatment solution. See, Gilgen, column 1, lines 54-56. Any effect Gilgen teaches on increasing the shelf life of nuts does not stem from contacting the nuts with water, because Gilgen teaches that the treatment solution can be made "by mixing a quantity of anti-oxidant, preferably tocopherol, with either heated water at 180° F., oil, or an aqueous solution of oil." Gilgen, at column 3, lines 11-13 (emphasis added). That is, the treatment solution can consist of the anti-oxidant and oil, without water being present at all. Thus, Gilgen's method permits the use of water, but does not require it. Gilgen's method does, however, require the presence of a preservative (an anti-oxidant) in the solution. *Id.*

In contrast, the present disclosure teaches the surprising finding contacting nuts with water, by itself, is sufficient to delay the development of rancidity. Specification at, e.g., page 10, lines 27-28. Example 1, page 13, lines 15-20, for example, shows that studies underlying the invention were conducted by simply ladling water onto nuts in a confectionary pan. It will be noted that the Example does not report the presence of other active substances, such as anti-oxidants, in the water.

To clarify the difference between Gilgen and the present invention, the amendment proposed to claim 21 recites that a preservative is not present in the water contacting the nut. The absence of a preservative is implicit in the specification, and would immediately be understood by one of skill in the art, for at least two reasons. First, as noted above, both the text and Example 1 refer to contacting nuts with water, but do not refer to the presence of protective agents. Second, even the most casual reader would appreciate that coating a nut with an agent keeping oxygen from the nut surface would retard rancidity. For example, coating the nut with shellac would be expected to retard the development of rancidity. In contrast, it is part of the surprising nature of the invention that contacting a nut with water alone is sufficient to delay the nut from becoming rancid. Finally, Applicants note for the record that it is not contemplated that a person wishing to practice the invention but to avoid the claims could simply use a trace amount of preservative in the water. The recitation regarding the presence of a preservative is intended to refer to amounts sufficient to have an effect as a preservative.

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Applicants respectfully submit that the rejection should be reconsidered and, upon reconsideration, withdrawn, in light of the discussion herein.

B. Rejection of the claims as obvious

The Action rejects claims 21-31 as obvious under 35 U.S.C. § 103(a) over Gilgen. According to the Action, Gilgen discloses treating a nut with an anti-oxidant to increase the shelf life of the nut. The Action indicates that the aspects of the dependent claims regarding abrading the nuts and how to contact the nuts with water would not be unexpected or unobvious.

Applicants amend in part and traverse.

As noted above, the amendment proposed to claim 21 recites that a preservative is not present in the water contacting the nut, while Gilgen requires the presence of an anti-oxidant. As amended, Applicants maintain that the claim is unobvious over Gilgen. Applicants respectfully submit that the rejection should be reconsidered and, upon reconsideration, withdrawn, in light of the discussion herein.

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CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance and an action to that end is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 415-576-0200.

Respectfully submitted,


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